

### **REMARKS**

In view of the following remarks, the Examiner is respectfully requested to allow claims 31 and 40, the only claims pending and currently under examination in this application.

#### **FORMAL MATTERS:**

Claims 31 and 40 are currently amended. Support for these amendments is found at least in the specification at paragraphs [0010], [0023], and [0038] and in Figures 3A-3E. The Applicants have also submitted an updated sequence listing.

The Applicants assert these amendments add no new matter and their entry is respectfully requested.

#### **REJECTIONS UNDER §103(a)**

The Examiner has rejected claims 31 and 40 under 35 U.S.C. §103(a), as allegedly being obvious in light of Williams et al., (US2004/0086913, henceforth "Williams"). The Examiner asserts that Williams discloses nucleic acids in any one of SEQ ID NOs: 1-316, that are expressed in human colon and could be used in the detection of colon cancer.

Williams discloses that SEQ ID NOs: 1-316 are "identifying sequences." These sequences are found by sequencing clones of cDNA libraries, clustering these sequences and using BLAST to segregate them into unknown, weak similarity and high similarity sequences when compared to genes contained in the GenBank database at the time of filing. By this method, Williams' experiments attempted to establish novel expressed genes. However, by using this methodology, Williams does not teach or suggest the DKKL-1 variants as disclosed in the instant application nor does Williams teach or suggest the currently claimed method of detecting colon cancer. As such, claims 31 and 40 are not obvious under 35 U.S.C. §103(a), and the Applicants respectfully respect withdrawal of this rejection.

#### **DOUBLE PATENTING**

The Examiner has provisionally rejected claims 31 and 40 under the doctrine of non-statutory, obviousness-type double patenting. The Examiner asserts that while claims 31 and 40 are not identical to claim 60 of co-pending US Patent Application No 11/887,692, they are not patentably distinct.

A terminal disclaimer properly filed under 37 C.F.R. §1.321(c)-(d) may be used to overcome an actual or provisional rejection based on non-statutory obviousness-type double patenting. The Applicants respectfully request that the provisional rejection of claims 31 and 40 be held in abeyance until the claims are considered allowable. If at that time, the Examiner still asserts that the claims may be rejected under obviousness-type double patenting, the Applicants will submit a terminal disclaimer.

CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at (510) 923-2438.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-4409, Customer No. 75074.

Respectfully submitted,

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